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EXAMINER

GARCIA, ERNESTO

ART UNIT PAPER NUMBER

3679

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,294

Applicant(s)

PAULSHUS, BJORN

S

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2004 and 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner on form PTO-892 has cited the references, they have not been considered.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference 19 in Fig. 1.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show "the strands 2a in the innermost ring or layer in tension member 1, preferably threaded into holes 6 in the first plate and the strands 2b in the outermost ring or layer in tension member 1 are preferably threaded into holes 6 in the second ring" as described in the

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specification (page 4, line 33 - page 5, line 3 of the original specification or at the end of page 5 through page 6, line 2 in the amended specification).

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the slip agent applied to the wall of each hole as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The amendment filed March 12, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: on page 3 in line 11 applicant added the terms "or other similar fiber types". There is no support in the disclosure to include all fibers known other than Carbon fibers, Kevlar fibers, or glass fiber. This statement implies to cover fibers not recited in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "tension member comprises an anchoring element" in line 2 of claim 11 is not in the specification, "a first socket and second socket" in line 2 of claim 14, and "threaded blind hole" is not in the specification.

The disclosure is objected to because of the following informalities: the use of the term "walls" throughout the specification, in particular "the walls 6 of the hole" on

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page 6 in line 12 is misleading when each hole has a conical wall and not more than one wall. Appropriate correction is required.

Claim Objections

Claims 11-21 are objected to because of the following informalities:

regarding claim 11, "which" in line 1 should be the, "its" in line 6 should be --a--, "the walls" in line 7 should be --a wall--, "walls" in line 8 should be --wall--, and the use of the terms "one or more strands" should be --at least one strand--;

regarding claims 13-14, these claims depend from cancelled claim 1;
for examination, the examiner assumed these claims depend from claim 11;
regarding claims 16-19, these claims depend from cancelled claim; for examination, the examiner assumed these claims depend from claim 15;

regarding claim 14, the first comma should be replaced with --including--;

regarding claim 15, "which" in line 1 should be --the--, "its" in line 4 should be --a--
-, "their" in line 6 should be --the--, and "the same" should be deleted;

regarding claim 20, "which" in line 1 should be --the--, "its" in line 4 should be --a--
, "their" in line 6 should be --the--, "at" in line 6 should be --the--, "termination
comprising" in line 8 should be deleted, "where" in line 9 should be --wherein--, "that" in
line 13 should be deleted, the second occurrence of "the" in line 14 should be --a--, and
"itself" in line 15 needs to be defined; and,

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regarding claim 21, "which" in line 1 should be --the--, "its" in line 4 should be --a--
--, "their" in line 6, "at" in line 6 should be --the--, "termination comprising" in line 8
should be deleted, and "where" in line 9 should be --wherein--. Appropriate correction is
required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to
comply with the written description requirement. The claim(s) contains subject matter
which was not described in the specification in such a way as to reasonably convey to
one skilled in the relevant art that the inventor(s), at the time the application was filed,
had possession of the claimed invention.

Regarding claim 11, line 3 recites "aramid fibers" in the Markush statement. This
type of fibers was not discussed in the disclosure. The examiner cannot find support for
aramid fibers. The original disclosure specifically only has support for carbon fibers,

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Kevlar fibers or glass fibers as indicated on page 3 in the third paragraph of the amended specification.

Regarding claims 12-14, the claims depend from claim 11 and therefore contain new subject matter.

Claims 11-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 11, 15, 20 and 21, the meets and bounds of the claims is unclear. Applicant claims a termination of strands in a tension member, in line 1, by limiting the tension member and without providing any structural limitations to the termination. In other terms, what exactly is the termination comprised of? Is the termination a different component that is inserted or located in the tension member?

Regarding claims 12 and 15, the limitation "the same plates" in line 2 in claim 12, and in line 6 in claim 15 is unclear. No other plates have been previously recited to make a comparison or make reference to similar plates.

Regarding claim 13, the claim depends from claim 11 and therefore is indefinite.

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Regarding claim 14, the limitation "it" in line 1 makes unclear what component should comprise at least two sockets, etc.

Regarding claim 15, it is unclear whether "the sockets and the plates" are the same feature. Since the hole is in the socket, the socket is something physical. According to the disclosure, the plate includes the hole. Shouldn't the plate be recited to include a hole instead of the socket or sockets?

Regarding claims 16-19, the claims depend from claim 15 and therefore are indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flory, 5,611,636.

Regarding claim 11, Flory discloses, in Figure 2, a termination in a tension member **12**. The tension member **12** comprises an anchoring element **12** comprising fibers **4** selected from a group consisting of carbon fibers **4** or aramid fibers (col. 5, lines 7-8). The fibers **4** are gathered into one strand or more strands **4**. The fibers **4** have a lower shear force and durability than steel. The strand or the strands **4** spread apart in a transitional region **22**. The one strand or the strands **4** is or are inserted into a respective hole **16** in at least one socket **14** and fixed in relation to the respective hole **16** by hardenable mass **72**. However, Flory fails disclose a slip agent applied to a wall of the respective hole **16**. Brandestini teaches, in Figures 1 or 2, a slip agent **50** applied to a wall of a respective hole to act as a suitable friction-reducing agent (col. 2, lines 46-56). Therefore, as taught by Brandestini, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a slip agent to the wall of the respective hole to acts as a suitable friction-reducing agent.

Regarding claim 12, a plurality of the strands are each anchored in respective holes in same plates so that the strands are anchored in a socket.

Regarding claim 13, the respective hole **16** tapers inward in a direction toward the tension member **12**.

Regarding claim 14, Flory discloses in Figures 3 and 4, it **30** comprises at least two sockets **34** including a first socket (Figure 3) and a second socket **34** (Fig. 4) joined

together. The first socket has a smaller diameter than the second socket. One of the strands is secured in the second socket to extend beyond the first socket (Fig. 2).

Allowable Subject Matter

Claims 15-21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 15, the prior art of record does not disclose or suggest a sleeve-shaped tightening screw is connected to a second socket;

regarding claims 16-19, these are assumed to depend from claim 15, and therefore are allowed;

regarding claim 20, the prior art of record does not disclose or suggest a termination of strands in a tension member comprising a nut securely holding a sleeve-shaped tightening screw between itself"; and,

regarding claim 21, the prior art of record does not disclose or suggest a termination of strands in a tension member comprising at least a first socket and at least second socket a second socket attached to one another by means of prestressed bolts extending through a through bore in the second socket.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E.G.

November 10, 2004



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